

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application Of:	Douglas Heintzman, <i>et al.</i>	Group Art Unit:	2629
Serial No.:	10/734,772	Examiner:	Tran, Henry N.
Filed:	December 12, 2003	Conf. No.:	1755
For:	Modifying Visual Presentations Based on Environmental Context and User Preferences	Atty. Dkt.:	2300.000300
		Client Docket:	AUS920030916US1
		Customer NO.:	46240

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby submit this Reply Brief to the Board of Patent Appeals and Interferences in response to the Examiner's Answer dated May 2, 2008.

It is believed that no fee is due; however, should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason, the Commissioner is authorized to deduct said fees from Williams, Morgan & Amerson, P.C. Deposit Account No. 50-0786/2300.000300.

I. THE CLAIMS, IN FACT, RECITE USER AUTHENTICATION

The Office opens its response to Applicants' arguments by stating, that the independent claims do not recite user authentication prior to retrieval of a user profile." (Examiner's Answer, p. 7) A review of the independent claims 1, 11, 19-20, and 25 set forth in Applicants' brief shows that:

- each of the method claims 1 and 25 recites "authenticating a user identification" and "receiving data ...associated with the authenticated user identification"; and
- each of the apparatus claims recites a component of some "adapted to" or a "means for" performing these functions.

The Office also stated that “[t]he copy of the appealed claims contained in the Appendix to the brief is correct.” (Examiner’s Answer, p. 2) Thus, the Office effectively conceded that this position is incorrect even before it was set forth. None of this stops the Office from pushing it erroneous position, however.

A. THE PHRASE “ADAPTED TO” DOES NOT READ THE LIMITATIONS OUT OF THE CLAIMS

The Office nevertheless first denies this on the grounds that claims 11 and 20 recite these limitations after the clause “adapted to”, and so therefore do not limit the scope of the claim. Note, then, that this first ground does nothing to rebut Applicants’ arguments with respect to the other independent claims. However, the more egregious error is that the Office states this as a *per se* principle of law, citing M.P.E.P. §2111.04. However, there is no such *per se* rule, as is evident on the face of the cited M.P.E.P. provision itself:

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. *However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:*

- (A) “adapted to” or “adapted for” clauses;
- (B) “wherein” clauses; and
- (C) “whereby” clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a “‘whereby’ clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.” *Id.* However, the court noted (quoting *Minton v. Nat’l Ass’n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a “‘whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.” *Id.*<

(emphasis added) Thus, the cite provision, on its face, repudiates the Office’s application of the principle as a *per se* rule. This also means that the Office has failed to carry its burden to

establish *prima facie* unpatentability since there is no consideration of “the specific facts of the case.”

And a consideration of the specific facts of this case reveal that the subject limitations do, in fact, limit the scope of the claims. Each of the recited limitations is an affirmative, functional recitation on the “control unit” or “processor-based device”—that is, a “control unit” or “processor-based device” that is not “adapted to” perform these functions will not fall within the scope of the claims. While it is true that the language—as is stated by the Office—does not require the actions to be performed, this is also irrelevant. The use of “adapted to” and similar phrases are a technique long accepted by the Office to afford the inventor of invention such as this one the full benefit of the bargain represented by the patent.

For example, the exclusive right under a patent is one to exclude others from making, using, selling, or offering to sell the claimed invention. If one must claim the apparatus as actually performing the recited functions that it is adapted to perform, one cannot stop others from making, selling, or offering to sell the claimed invention. The inventor would therefore be denied the full benefit of the bargain inhering the patent simply through the elevation of form over substance in precisely the manner advocated by the Office in this case.

It is therefore evident that this first ground is nothing more than a misapplication of the legal principle stated in M.P.E.P. §2111.04. The Office seeks to apply it as a *per se* rule when the provision repudiates such an application on its face. When the specific facts of the present case are examined as is required by that provision, it becomes apparent that the subject limitations affirmatively impose functional limitations on the recited structure.

B. THE CLAIM LANGUAGE REQUIRES USER AUTHENTICATION PRIOR TO INFORMATION RETRIEVAL

The Office next denies that subject limitations are meaningful because, allegedly, the claim language does not actually require user authentication prior to user profile retrieval. This position contradicts fundamental and basic precepts of the English language. The limitation in each of the independent claims 1, 11, 19-20, and 25 uses the language “authenticated user identification”. The adjective “authenticated” so clearly modifies the noun “user identification” that the Office has not even bothered to deny it. The word “authenticated” is the past tense of the verb “authenticate”—that is, it is the form that indicates that the action *has already occurred*.

Thus, when the claims call for “receiving data associated with at least one visibility profile associated with the authenticated user identification”, for example, the phrase “authenticated user identification” undeniably indicates that the authentication has already occurred. Since the authentication is also recited, *the claim language inherently requires that the authentication and receiving limitations are ordered such that authentication occurs prior to receiving data*. The language “prior to” therefore does not necessarily have to appear for the ordering to be present. Accordingly, application of basic grammatical principles of the English language repudiates this second ground.

C. THE THIRD GROUND IS NOT REALLY A RESPONSE

Finally, the Office alleges challenges Applicants’ position on the ground that the art of record does actually disclose these limitations. This is not a response—this is merely a reiteration of the Office’s position. Applicants and the Office clearly disagree on the proposition of what the art of record teaches. Otherwise, this appeal would not have been instituted. This “response” therefore is immaterial because it does not to actually address Applicants’ argument that Davis fails to teach this limitation.

D. THE OFFICE HAS NO EFFECTIVE RESPONSE TO APPLICANTS’ POSITION

It therefore happens that the Office has *no* effective response to Applicants’ position that the art of record fails to teach “authenticating a user identification” prior to “receiving information” predicated on the authenticated user identification. The Office’s first ground that this is not an affirmative limitation on the claims is in actuality a misapplication of a legal principle. The second ground is repudiated on basic grammar principle. And the third ground is not actually a response—it is instead a reiteration of the Office’s position that the art of record teaches the limitation. The Office therefore has not countered any of Applicants arguments that the art of record fails to teach all the limitations of the claims.

II. THE ART OF RECORD STILL FAILS TO TEACH AUTHENTICATION

The Office also responds to Applicants' arguments by again reiterating that the art of record teaches authentication, but this time adding additional evidence and argument. The first ground is that "only" claims 1, 19, and 25 recite "authentication". Again, a quick review of the claim language that the Office concedes is correct repudiates this position. It therefore appears to be an implied invocation of the Office's previous position that the language, although present, does not actually limit the scope of the claims. Applicants therefore incorporate their reasoning above in I.A. as to why this is incorrect and turn their attention to the other ground put forth by the Office.

The other ground put forth by the Office is that the claims do not define the phrase "authenticate a user identification" and that extrinsic evidence establishes that authentication, by definition, includes validation user long information. The most immediate error in that position is that it the claims are not supposed to define the terms they use. It is an elementary principle of patent law that the claims define the scope of the invention and that, to the extent terms need defining, this is done in the detailed description. The second error is that this response relies upon new evidence that is improperly relied upon at this point of the prosecution. (Note that the dictionary definitions relied upon do not appear in the "Evidence Relied Upon" section of the "Examiner's Answer".)

But, the bigger error in this response is that it actually supports Applicants' position in detriment to that of the Office. The dictionary definition establishes that "identification", as taught in the art of record, is different from "authentication", which is what Applicants claim. More particularly, the definition establishes that "authentication" requires not only "identification," but also the further act of "validating" that identification. Accordingly, far from countering Applicants' arguments, this extrinsic evidence actually supports Applicants' position.

III. THE "OBVIOUSNESS RESPONSE" IS SIMILARLY FLAWED

In responding to Applicants' position with respect to obviousness, the Office once again disagrees that the art of record in fact teaches all the limitations of the claim. The Office puts forth three reasons for this: (1) the subject art was cited against a different set of claims that what

Applicants' argued, (2) the secondary reference was not relied upon for teaching authentication, and (3) the primary reference was relied upon to teach authentication. (Examiner's Answer, pp. 9-10) Aside from the logical inconsistency between the premise/conclusion and the reasons set forth, the reasons are all incorrect.

**A. DAVIS AND LIN ARE CITED IN COMBINATION
AGAINST CLAIMS 6, 8, 22, AND 23**

The Office's first reason is that "...Davis and Lin references [*sic*] are used to rejected [*sic*]claims 6, 8, 22, and 23 instead of claims 3-10, 13-15, 24, and 27-29". Applicants note that they correctly stated that Davis and Lin were asserted in combination against claims 6, 8, 22, and 23 on multiple occasions. Applicants correctly stated that the combination was asserted against claims 6, 8, 22, and 23 in the "Status of the Claims" ("Appeal Brief", p. 2), in the "Grounds of Rejection to Be Reviewed on Appeal" ("Appeal Brief, p. 9), and in the "Argument" ("Appeal Brief", pp. 11-12).

Applicants concede that the closing sentence of the argument did erroneously list claims 3-10, 13-15, 24, and 27-29. However, in light of the other multiple, correct statements, it is clear that this was merely a clerical error. Even were this not true, Applicants also stated that the correct claims in the argument, as well. The erroneous listing therefore is of no consequence since the correct claims were listed as well. This "response" is therefore a red herring and is immaterial to any argument raised in this appeal.

**B. NOBODY EVER SAID LIN WAS RELIED UPON
TO TEACH "AUTHENTICATION"**

The Office next responds that "...Lin reference is not relied upon for the teaching of the 'authentication'". Applicants never made such an assertion. What Applicants said was, "The Office conceded that Lin omits any such teaching by withdrawing the earlier anticipation rejections base on Lin in light of the amendment adding 'authentication.'" ("Appeal Brief", p. 12) The two statements are not equivalent. Thus, this response is also a red herring and immaterial to any argument raised in this appeal.

C. NOBODY DISPUTES THAT DAVIS IS RELIED UPON FOR TEACHING “AUTHENTICATION”

Finally, the Office states that “...Davis reference is relied upon for teaching of the ‘authentication’ as discussed in item (10)(a)(ii) above.” Applicants do not dispute the proposition that the Office relies upon Davis for teaching “authentication”. Indeed, Applicants affirmatively stated, “[t]hese rejections rely on Davis to teach the ‘authentication’ recited in the claims....” (“Appeal Brief”, p. 12) However, one construction of this “response” is that the Office is incorporating its earlier discussion to the effect the Davis does, in fact, teach authentication. Should this be the import of this “response”, then Applicants incorporate their previous arguments in this appeal that Davis fails to teach “authentication”. This would include the Office’s newly introduced “evidence” that “authentication” and “identification” are different.

IV. CONCLUSION

Thus, in response to the Examiner’s Answer, Applicants respectfully points to the following facts adduced from the evidence of record as in this appeal:

- the independent claims are limited to “authentication” of, or an ability to “authenticate”, a “user identification”;
- “authentication” and “identification” are different functions in the context of a computing environment;
- the primary reference Davis teaches “identification,” which is different from “authentication”, instead of “authentication”;
- the secondary reference Lin is not relied upon to teach “authentication”; and
- the Office has conceded that Lind does not teach “authentication”.

Applicable legal principles, as applied to these facts, results in the following legal conclusions:

- Davis does not anticipates any claim because it fails to teach “authenticating” a “user identification”, M.P.E.P. §2131 (an anticipating reference must disclose every limitation of the rejected claim); *In re Bond*, 15 U.S.P.Q.2d (BNA) 1566, 1567 (Fed. Cir. 1990); and
- Davis and Lin fail to render obvious any claim because, in combination, they fail to teach “authenticating” a “user identification”, M.P.E.P. § 706.02(j) (the prior

art reference (or references when combined) must teach or suggest all the claim limitations); *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974).

Wherefore, Applicant prays that all rejections be **REVERSED**, and the claims allowed to issue.

Respectfully submitted,

Date: July 2, 2008

WILLIAMS, MORGAN & AMERSON
10333 Richmond Dr., Suite 1100
Houston, Texas 77042
(713) 934-4053 ph

/Jeffrey A. Pyle/
Jeffrey A. Pyle
Reg. No. 34,904
Attorney for Applicants